

REMARKS

The Office Action mailed August 2, 2006 has been carefully considered. Within the Office Action Claims 46-55 and 94 have been rejected. The Applicants have amended Claims 46, 47, 55, 94, 104 and 113 and have withdrawn only Claims 86, 89-93, 96, 99-103, 105, 108-112. The Applicants reserve the right to rejoin the withdrawn claims upon allowance of the base claims upon which they are dependent. Reconsideration in view of the following remarks is respectfully requested.

Improper Restriction Requirement

A restriction requirement had been imposed by the Examiner in the Office Action dated August, 8, 2006, whereby claims 85-93 and 95-103 had been improperly been alleged to represent a species in Figure 4 of Applicants' specification and were allegedly presented by claims 56-64. In addition, it is alleged that claims 104-115 allegedly represent the invention in Figures 4-6 and are alleged to be copied from originally presented claims 56-64. The Applicants respectfully traverse and submit that Claims 85, 87-88, 95, 97, 98, 104, 106, 107 and 113 be considered. The Applicants, however, do withdraw claims 86, 89-93, 96, 101-103, 105, and 108-112 without traverse.

Under M.P.E.P. § 808, every restriction requirement has two requirements which must be presented by the Examiner to provide a prima facie case for a proper restriction requirement. See M.P.E.P. § 808. The requirements are that the Examiner must provide (a) reasons, as distinguished from the mere statement of conclusions, why each invention as claimed is either independent or distinct from the other; and (b) why there would be a serious burden on the Examiner if the restriction is not required. Id. (emphasis added).

Under M.P.E.P. § 808.01, the particular reasons relied on by the Examiner for holding that the claimed invention(s) are either independent or distinct should be concisely stated. A mere statement of conclusion is inadequate. Therefore, the Examiner must show one of the following: that there is a separate classification between the distinct inventions; that a separate status in the art is applied to each invention even though they may be classified together; or that it is necessary to search different fields of art for the distinct inventions. In the present case, the Examiner has not provided any statements or provided any arguments as to how the embodiments in Claims 85, 87, 88, 95, 97, 98, 104, 106-107 and 113 are distinct from one another.

In addition, the Examiner has not provided any reasons as to why there would be an excessive burden to search the embodiments in 85, 87, 88, 95, 97, 98, 104, 106-107 and 113. In particular, Claims 85, 95 and 106 all recite the housing having a moveable portion relative to a base portion. Claims 87, 97 and 107 all recite that the moveable portion is a button. Claims 88, 98 and 108 all recite that the moveable portion is graspable by a user. The Examiner has provided no arguments to establish that searching for a housing with a moveable portion, which may be a button in an embodiment and may be graspable would be burdensome and would require searches in other fields. In fact, the Examiner admitted in the Restriction Requirement dated June 8, 2006 that each of the Groups of inventions are in Class 345, Subclass 163. (Restriction Requirement dated June 8, 2006, Paragraph I). The Examiner states that claims 85, 87, 88, 95, 97, 98, 104, 106-107 and 113 were copied and already claimed and were independent and distinct inventions in non-elected claims 56-64, but this is not correct. The non-elected claims 56-84 included other features (e.g. magnet, stop member, etc.) which may afford the embodiments to be patentably distinct and independent. However, the Examiner has not satisfied a *prima facie* case of showing that a restriction requirement is warranted for Claims 87,

88, 95, 97, 98, 104, 106-107 and 113. For at least these reasons, the restriction requirement on Claims 87, 88, 95, 97, 98, 104, 106-107 and 113 is improper and should be withdrawn.

In addition, it is stated in the Office Action that Claims 85-93 and 95-103 represent species of Figure 4 and that Claims 104-115 represent the species in Figures 4-6. The Applicant also traverses the Restriction Requirement and the Examiner's comments on Claims 87, 88, 95, 97, 98, 104, 106-107 and 113 on the basis that the identification of species based upon figures unduly limits the scope of protection of any of the elected species. Should any of the current claims, or any claims added later in prosecution, be deemed by the Patent Office or a court to be read under 35 U.S.C. 112, paragraph 6, then those claims would be potentially limited to the embodiment shown in the elected figure(s). However, election of a species based on a figure or figures, where all other species are also identified by a figure or figures, has the effect of "removing" from the specification all figures not identified as being a part of the elected species. In the present case, under the current Restriction Requirement, if the Applicants were to agree with the Examiner's statements, the embodiments in Figures 4-6 would be effectively removed from the scope of Claims 46, 94, 104 and 113. This is an improper use of the Restriction Requirement tool, and for at least these reasons, the Applicants respectfully traverse and submit that the current Restriction Requirement is improper.

Should the Examiner elect to maintain the present Restriction Requirement or otherwise reject this application finally or non-finally for the Applicants' traversal stated above, then this paper is to be treated as a petition to the Director under 37 C.F.R. §1.183 to waive such rules as necessary, in the interests of justice, to prevent an unnecessary extinguishment of the Applicants' rights as detailed above. Any fees associated with the petition may be charged to our deposit account as set forth below.

Judicially-created Double Patenting

Claims 46-55 were rejected pursuant to the judicially-created doctrine of obviousness-type double patenting as being unpatentable over claims 1-10 of prior United States patent No. 6,71,573. Submitted herewith is a Terminal Disclaimer executed by Applicants' attorney of record. Withdrawal of this rejection is respectfully requested.

Rejection under U.S.C. § 102

Claims were rejected under 35 U.S.C. § 102(b) as being allegedly anticipated by Japanese patent 09-026850 to Ozaka (hereinafter "Ozaka") The Applicants respectfully traverse.

According to the M.P.E.P., a claim is anticipated under 35 U.S.C. § 102(a), (b) and (e) only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.

Claim 46 recites, among other things, an eccentric mass coupled to the actuator, the actuator configured to rotate the eccentric mass with a sudden acceleration to output an inertial haptic force pulse. Claim 94 recites, among other things, an actuator coupled to the housing and having an eccentric mass, the actuator configured to actuate the eccentric mass with a sudden acceleration and deceleration to output an inertial haptic pulse force in response to an actuating signal.

Ozaka does not teach that the reaction force caused by the dc motor is suddenly accelerated/decelerated to produce an inertial haptic force pulse. In regards to paragraphs 29-31 in Ozaka, all that is described is that a reaction force is applied which makes the actuation "heavier" than usual. Considering that Ozaka describes this in the context of moving the pointer while its in the boundaries of the icon, Ozaka is describing a texture feeling, such as damping or braking in which the actuation feels heavier. This is further supported in paragraph 32 where this

type of reaction force is applied when dragging objects 33. Accordingly, Ozaka does not teach each and every element and limitation in Claims 46 and 94. Accordingly, Claims 46 and 94 are allowable over Ozaka.

Claim 104 recites, among other things, an actuator coupled to the moveable portion of the housing, the actuator having an eccentric mass and configured to actuate the eccentric mass to output an inertial haptic force to the moveable portion in response to an actuating signal from the computer device. In addition, Claim 113 recites, among other things, means for producing an inertial haptic force to the moveable portion, the means for producing having an eccentric mass rotated about a shaft in response to an actuating signal from the computer device. Ozaka does not teach any component which produces an inertial haptic force to a moveable portion of the housing. Accordingly, Ozaka does not teach each and every element and limitation in Claims 104 and 113. Accordingly, Claims 104 and 113 are allowable over Ozaka.

Claims 47-55, 85, 87 and 88 are dependent on Independent Claim 46; Claims 95, 97 and 98 are dependent on Independent Claim 94; and Claims 106 and 107 are dependent on Independent Claim 104. For at least the reasons stated above, Claims 46, 94 and 104 are allowable over Ozaka. Accordingly, Claims 47-55, 85, 87, 88, 95, 97, 98, 106 and 107 are allowable for being dependent on allowable base claims.

Rejection under 35 U.S.C. § 103

Claims 47, 53 and 55 were rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over Ozaka in view of U.S. Patent No. 6,411,280 to Aarts (hereinafter “Aarts”). This rejection is respectfully traversed.

Claims 47, 53 and 55 are dependent on Independent Claim 46. For at least the reasons stated above, Claim 46 is allowable over Ozaka. Accordingly, Claims 47, 53 and 55 are

allowable over Ozaka and Aarts, individually or in combination, for being dependent on allowable base claims.

In addition, Applicants would like to point out that the Office Action states, in regards to dependent claim 55, that the actuator taught in Ozaka is a DC motor and it is obvious to be able to rotate the motor in two directions to output an inertial haptic effect. The Applicants assume that the Office Action has intended to take official notice of these facts under M.P.E.P. 2144.03 that the rationale supporting the obviousness rejection is based on common knowledge in the art or "well-known" prior art. Under M.P.E.P. 2144.03, "[i]f the applicant traverses such an assertion the examiner should cite a reference in support of his or her position." Applicant hereby traverses this assertion brought by the Examiner and respectfully requests that a reference be cited in support of the position outlined in the Office Action in regards to dependent Claim 55. Otherwise, the Applicants respectfully request that the rejection to Claim 55 be withdrawn, and Claim 55 be allowed.

Conclusion

It is believed that this reply places the above-identified patent application into condition for allowance. Early favorable consideration of this reply is earnestly solicited.

If, in the opinion of the Examiner, an interview would expedite the prosecution of this application, the Examiner is invited to call the undersigned attorney at the number indicated below.

Applicant respectfully requests that a timely Notice of Allowance be issued in this case. Please charge any additional required fee or credit any overpayment not otherwise paid or credited to our deposit account No. 50-1698.

Respectfully submitted,

THELEN REID & PRIEST, LLP

Dated: _____



Khaled Shami
Reg. No. 38,745

Thelen Reid & Priest LLP
P.O. Box 640640
San Jose, CA 95164-0640
Tel. (408) 292-5800
Fax. (408) 287-8040